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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,154	07/03/2003	Anna-Carin Elfstrom	018798-171	4120

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EXAMINER

HAND, MELANIE JO

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,154

Applicant(s)

ELFSTROM ET AL.

Examiner

Melanie J. Hand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/25/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 120 from copending Provisional Application No. 60/393,598 filed on July 5, 2002.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on September 25, 2003 was filed after the mailing date of the Application on July 3, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

Claims 15 and 24 are objected to because of the following informalities: the phrases "such as at an angle of 45°" in Claim 15 and "such as cellulose fluff" in Claim 24 must be removed from the claims as these phrases constitute exemplary language that is not permissible in claim language.

Claims 16 and 17 are objected to because of the following informalities: Applicant claims a U-shaped liquid barrier, assumed by Examiner to have a straight edge at the top and therefore the barrier claimed is interpreted to be in

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the shape of a trapezoid. Examiner is interpreting the phrase "along an acute angle" and "U-shaped" in Claim 16 as signifying that the angles along which the folds are made with respect to a transverse axis as claimed in Claim 16 are equal in magnitude, although the limitation "less than 45°" would require that the angle opposite the "less than 45°" angle at the base of the trapezoid would have to be greater than 45°, contradicting applicant's own limitation.

Claim 24 is objected to because of the following informality: the phrase "possibly with highly absorbent material" does not clearly define the invention claimed.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-8, 12-14 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Runeman et al (U.S. Patent No. 5,486,168).

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With respect to **Claim 1**: Runeman teaches incontinence guard 1 for men comprised of a liquid permeable layer 2, liquid impermeable layer 3, and absorbent pad 4 enclosed between layers 2 and 3 (Fig. 2) (Col. 2, lines 51-54). Guard 1 has a front region, a curved container-like part 7 for embracing all or part of the user's scrotum during use, and end 10. (Fig. 2) As shown in Fig. 1, Runeman teaches that the absorbent body 4 tapers toward end 10 from edge 5c, end 10 being that end which is lower than but closest to container 7 for receiving the user's genitals. Runeman teaches that layers 2 and 3 project slightly beyond the edges of pad 4 where they are mutually joined (Col. 3, lines 7-10), thereby enclosing the absorbent pad 4. Runeman teaches that side flaps 6a, 6b have elastic devices 9 attached to them (Col. 3, lines 17-20) which generate the curved container 7 as well as provide leakage-preventing barriers (Col. 3, lines 51-53).

With respect to **Claim 2**: Runeman teaches a guard that is intended to be worn closest to the user's body during use (Col. 1, lines 10,11). Runeman teaches that guard 1 is able to remain in place over the user's genitals with the aid of the elastic devices 9 located in side flaps 6a,6b (Col. 3, lines 60-62).

With respect to **Claim 6**: Runeman teaches container 7 that is formed from the absorbent pad 4 when elastic devices 9 in side flaps 6a,6b are shortened, corresponding to the curvature of pad 4 in the lower region (Col. 3 , lines 29-38).

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With respect to **Claim 7**: Runeman teaches that container 7 is formed when pad 4 is curved, therefore container 7 extends across the entire pad 4 in the transverse direction. As shown in Figure 2 taught by Runeman, the container is convex in the direction of the narrower end.

With respect to **Claim 8**: Runeman teaches that the absorbent pad 4 is bent outward to form container 7, a portion of which extends below the plane of the absorbent pad 4, therefore it is considered here to extend beyond the absorbent pad 4 in the lateral direction.

With respect to **Claim 12**: Runeman teaches container 7 which is considered here to be raised away from the plane of the article and thus the liquid permeable layer 2 which is defined by the front section at every point except side edges 6a, 6b where the container 7 is considered here to be in contact with the plane of the article.

With respect to **Claim 13**: Runeman teaches that planar absorbent pad 4 (Fig. 1) is bent outward from the plane of the pad and elastic devices 9 added to side flaps 6a,6b which pull the bent pad portion upright and toward the plane of the pad, therefore effecting the formation of a roll from a band shaped material, i.e. the planar pad and thereafter the formation of curved container 7.

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With respect to **Claim 14**: Runeman teaches that the resistance to bending along axes parallel to edge 5c decrease toward end 10, where the pad 4 curves or bends more noticeably (Col. 3, lines 31-34). As shown in Figure 1, edge 5c is a top edge and extends both ways in the transverse direction. Since the least resistance to bending of the pad occurs along axes that are parallel but closer to end 10 as opposed to central in the pad, the fold that produces container 7 is considered here to be a circumferential fold because, though the pad is not entirely rolled back on itself, the folding path is circular.

With respect to **Claim 18**: Runeman teaches that the liquid impermeable layer 3 that comprises the band that container 7 is fabricated from is made of hydrophobized nonwoven material (Col. 3, lines 3-6).

With respect to **Claim 19**: Runeman teaches that pad 4 is bent at a point closer to end 10, forming container 7.

With respect to **Claim 20**: Runeman teaches that band 4 is enclosed in layers 2 and 3, layer 3 comprised of nonwoven hydrophobic material, therefore the band that container 7 is formed from is comprised of hydrophobic nonwoven material.

With respect to **Claim 21**: Runeman teaches that planar absorbent pad 4 (Fig. 1) is bent outward from the plane of the pad and elastic devices 9 added to side flaps 6a,6b which pull the bent pad portion upright and toward the plane of the

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pad, therefore effecting the formation of a roll from a band shaped material, i.e. the planar pad and thereafter the formation of curved container 7.

With respect to **Claim 22**: Runeman teaches that elastic device 9 may be an elastic thread (Col. 3, lines 18-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Runeman in view of Olson et al (U.S. Patent Application Publication No. 2003/0181883).

With respect to **Claim 3**: Runeman does not teach a product with a pants shape. Olson teaches a garment –like absorbent article with a front region 22 and back region 24 with front and back waist edges 38 and 39, respectively, that are configured to encircle the waist (Paragraph 0043). Olson teaches elastic waist members 54 and 56 that are operatively joined to the outer cover 40 or bodyside liner 42 along opposite waist edges 38 and 39 (Paragraph 0076).

With respect to **Claim 4**: Runeman does not teach at least one elastic member that enables the front section to be pulled below the user's penis. Olson teaches an absorbent garment with elastic waist edge 54 that is operatively joined to body side liner 42 wherein the user can pull the garment down counter to the action of the elastic member, enabling the absorbent assembly 44 positioned between the bodyside liner 42 and outer cover 40 (Paragraph 0041) to also be pulled down to a level below the user's penis. The absorbent assembly 44 can subsequently be returned to its initial position when the user pulls the elastic member and waist edge up by and returns the waist edge 38 with elastic member 54 to its initial position. Olson teaches side panels 34 that include an elastic material that stretches in a direction parallel to the transverse axis 49 of the garment 20, which would allow the top edges of side panels 34 to remain in their initial position even when front region 22 is pulled down by the user.

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With respect to **Claim 5**: Olson teaches that both front region 22 and back region 24 are attached to side panels 34 which are generally rectangular in shape.

Olson teaches elastic member 54 with an elongate shape operatively connected to front region 22 having two opposing end edges adjacent the front portions of side panels 34 and opposing longitudinal side edges. The width of elastic member 54 is less than the length of side panel 34, as is clearly shown in Fig. 2.

The longitudinal direction of elastic member 56 is parallel to the transverse axis 49 of the garment, while the longitudinal direction of side flaps 34 is parallel to the longitudinal axis of the garment (Paragraph 0045), therefore making the longitudinal axes of the elastic member 54 and the side flaps 34 perpendicular to one another. Olson teaches that side panels 34 are integrally formed with the outer cover 40 and/or the bodyside liner 42, therefore they are connected to both longitudinal edge sections of elastic member 54. A central region of elastic side panel 34 is therefore also operatively connected to said first longitudinal edge section of elastic member 54. The garment 20 of Olson is considered to be applied in its entirety on elastic member 54 because, as stated previously, Olson teaches that elastic member 54 is operatively connected to front region 22.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Runeman in view of Sherrod et al (U.S. Patent No. 5,558,734).

With respect to **Claims 9-11**: Runeman does not teach a height for container 7.

Sherrod teaches an incontinence article with retaining member 82 comprised of

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compartment 86 for housing the user's penis. Sherrod teaches that the length of compartment 86 measured from opening 92 is at least 5 cm (50 mm). Sherrod teaches that this compartment is sized to accommodate the varied sizes of male genitalia. Therefore it would be obvious to modify the container 7 taught by Runeman to have a height of at least 5 cm to accommodate a wider range of users.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Runeman in view of Slater (U.S. Patent No. 5,810,799).

With respect to **Claim 15**: Runeman does not teach that container 7 is V-shaped liquid barrier with the point of the V pointing toward the crotch region of guard 1. Slater teaches a diaper for use by a human male with a triangular-shaped liquid barrier 1011 (Fig. 10). Slater teaches that the pouch or barrier 1011 is large enough not to constrict the penis 1016 yet acts as a barrier by accepting the upper part of the penis and preventing urine from spraying upward toward the user's head. Since barrier 1011 performs the same function as container 7 but does not have the point of the triangular pouch facing the crotch region, Examiner believes that it would be obvious to invert the orientation of the barrier of Slater to yield a functional equivalent of the barrier claimed by Applicant. Since Slater teaches that the pouch or barrier 1011 is large enough not to constrict the penis 1016 yet acts as a barrier by accepting the upper part of the penis and preventing urine from spraying upward toward the user's head,

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it would be obvious to modify the container 7 taught by Runeman to have a "V" or triangular shape as taught by Slater.

With respect to **Claim 16**: Runeman does not teach that container 7 is V-shaped liquid barrier with the point of the V pointing toward the crotch region of guard 1. Slater teaches a diaper for use by a human male with a trapezoidal-shaped liquid barrier 1111 (Fig. 11) positioned to reside above the male penis to accommodate at least a portion of the penis when worn (see Abstract). Slater teaches that the barrier is directed to providing a means for keeping upwardly spayed urine from escaping the confines of the diaper. Since barrier 1111 performs the same function as container 7 but does not have the base of the trapezoidal profile pouch facing toward a crotch region as set forth by Applicant, Examiner believes that it would be obvious to invert the orientation of the barrier 1111 of Slater to yield a functional equivalent of the barrier claimed by Applicant. Therefore it would be obvious to modify the container 7 taught by Runeman to have a trapezoidal shape as a trapezoidally shaped barrier performs the same function of absorbing inadvertent discharges of urine as taught by Slater.

With respect to **Claim 17**: Runeman does not teach that container 7 is trapezoidal in shape. Slater teaches a trapezoidal-shaped liquid barrier. Slater does not teach that the acute angle is less than 45°. Examiner is interpreting the phrase "an acute angle" in Claim 16 as signifying that the angles along which the

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folds are made with respect to a transverse axis as claimed in Claim 16 are equal in magnitude. Since Slater teaches a trapezoidal barrier, at least one of the acute angles in the trapezoid is equal to or less than 45°, therefore the trapezoidal barrier 1111 taught by Slater qualifies as prior art anticipating Claim 17.

With respect to **Claim 23**: Runeman does not teach that container 7 has sufficient inherent stiffness for end 10 to be held in the raised state. Slater teaches barrier 311 (Fig. 3) that is formed from a single piece of absorbent folded over and subsequently adhered to the interior surface of the front portion 207 of inner portion 206 of a diaper (Col. 3, lines 40-45). It is interpreted here therefore that the barrier has sufficient inherent stiffness for the free longitudinal edge of barrier 311 to remain in the raised state.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Runeman et al (U.S. Patent No. 5,486,168).

With respect to **Claim 24**: Runeman teaches that absorbent pad 4 is comprised of an absorbent fiber fluff material and that the fluff is admixed with superabsorbent material (Col. 2, lines 54-59). Runeman does not teach a molding applied to the contour of container 7 on our outside of container 7. Since applicant has not stated that placing molding comprised of absorbent fluff along the contour of liquid barrier 17 provides an advantage, is used for a particular purpose, or solves a stated problem, at the time the invention was made, it would

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have been an obvious matter of design choice to a person of ordinary skill in the art to add an absorbent fluff molding to the contour of the narrow end of container 7 on or outside the container 7 taught by Runeman. One of ordinary skill in the art, furthermore, would have expected the container 7 of Runeman, and Applicant's invention, to perform equally well either with or without molding comprised of absorbent fluff placed along the contour of the narrow end of container 7 because both container 7 taught by Runeman and liquid barrier 17 set forth by applicant would perform the same function of absorbing discharged urine from a user's penis equally well considering both container 7 and liquid barrier 17 are structured and comprised of absorbent fluff so as to envelop at least a portion of the user's penis and absorb any discharged urine, preventing it from soiling the user's undergarment.

Therefore, it would have been prima facie obvious to modify the container 7 of Runeman to obtain the invention as specified in claim 24 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Runeman.

With respect to **Claim 25**: Runeman does not teach that the absorbent material that container 7 and pad 4 is comprised of is a foam material.

Since applicant is claiming that the foam is precast into the desired shape, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to vary the absorbent fluff that pad 4 is comprised of to be a precast or preshaped foam material rather than

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fluff because Applicant has not disclosed that the absorbent material claimed in Claim 1 in precast or preshaped foam form provides an advantage, is used for a particular purpose, or solves a stated problem as opposed to the same material in fluff form. One of ordinary skill in the art, furthermore, would have expected the fluff in pad 4 taught by Runeman, and Applicant's invention with precast or preshaped foam absorbent, to perform equally well with either fluff or precast foam because both fluff and precast or preshaped foam absorbent would perform the same function of absorbing urine discharged from the user's penis equally well considering both the fluff and foam are absorbent materials.

Therefore, it would have been prima facie obvious to modify the container 7 of Runeman to be comprised of foam absorbent to obtain the invention as specified in claim 25 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Runeman.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

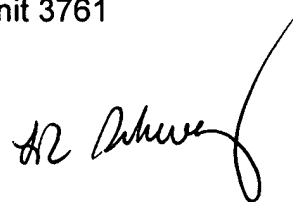
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on 571-272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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MJH

Melanie J Hand
Examiner
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A handwritten signature in black ink, appearing to read "Larry I. Schwartz", with a long, sweeping flourish extending from the end.

Larry I. Schwartz
Supervisory Patent Examiner
Group 3700